

REMARKS

Applicants have carefully reviewed and considered the Examiner's Office Action dated February 8, 2005. Reconsideration is respectfully requested in view of the following comments.

By this Amendment, claims 7-10 and 11-12 are canceled and claims 13-17 and 20 are amended to provide consistency with the recitation "telephone directory application software" throughout the claims. Claims 1-6 and 13-21 are pending in the present application upon entry of the foregoing claim amendments.

The Action requires the surrender of the original patent in paragraph 1 of the Detailed Action. On September 21, 2004, 37 CFR § 1.178 was revised and the physical surrender of the original patent has been eliminated. Surrender of the original patent is now automatic upon the grant of the reissue patent. This final rule applies retroactively to all pending reissue applications. 37 CFR §1.178 now states: "The application for reissue of a patent shall constitute an offer to surrender the patent and the surrender will take effect upon the reissue of the patent." Accordingly, it is believed that filing of this reissue application satisfies the surrender of the original patent required by paragraph 1 of the Action.

Claims 13 and 14-21 were rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,020,974, as set forth in paragraph 3 spanning pages 3-4 of the Action. This is a reissue application of U.S. Patent No. 6,020,974. Thus, the patent of which claims 13 and 14-21 are rejected under the judicially created doctrine of obvious-type double patenting was automatically offered to be surrendered at the time the present reissue application was filed.

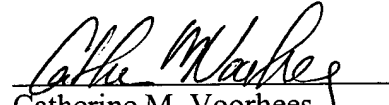
That is, Applicants offered to surrender the original application by the filing of the reissue application as 37 CFR § 1.178 now states. Thus, contrary to the Action's response to the previous double patenting rejection arguments, Applicants have more than "merely [alleged] to surrender the original patent." Moreover, MPEP 1405 states that "35 U.S.C. 251 prescribes the effect of reissue on the patent term by stating that 'the Director shall ... reissue the patent ... for the unexpired term of the original patent.'" Accordingly, there is no patent term to disclaim and thus, the double patenting rejection should be moot.

Inasmuch as the judicially created doctrine of double patenting rejection was the sole rejection applied to claims 13 and 14-21, it is believed that the foregoing amendments and the remarks in lieu of the submission of a Terminal Disclaimer place the present application in condition for allowance.

For the above stated reasons, it is submitted that all of the pending claims, i.e., claims 1-6 and 13-21, are allowable over the prior art of record and are in condition for allowance. Therefore, it is respectfully submitted that this Amendment After Final Rejection places the application in condition for allowance; does not raise new issues that require further consideration and/or search as the changes to claims 13-17 and 20 are consistent with terminology used in the specification and in previously presented claims (e.g., claim 18); and do not raise the issue of new matter. Accordingly, Applicants respectfully request that this Amendment After Final Rejection be entered and that this application be passed to issuance.

Should the Examiner believe that a conference would advance the prosecution of this application, she is encouraged to telephone the undersigned counsel to arrange such a conference.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Cathy Voorhees", is written over a horizontal line.

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